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EXAMINER

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/784,479  
Filing Date: February 15, 2001  
Appellant(s): PETKOVSEK, GLENN

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Brian M. Mattson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/15/2006 appealing from the Office action mailed 6/22/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|                 |              |                   |
|-----------------|--------------|-------------------|
| US 2002/0120680 | Greco et al. | August 29, 2002   |
| US 2002/0019741 | Heston       | February 14, 2002 |

Art Unit: 3639

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. (US 2002/0120680 A1) in view of Heston (US 2002/0019741 A1).**

Greco et al. (Greco) teaches a method and system for providing electronic document services, comprising:

#### **Claims 1 and 12,**

providing a service provider server and user (client) computer; said server and user computer are configured to communicate over the Internet; said user computer includes a browser to locate said service provider on the Internet [0006]; [0051]; [0089];

providing a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information relating to processing and delivery of a document (communication) by Internet-based document-related services (special service) [0012]-[0014]; [0051]; said information further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084];

inputting user unique information into the database via the user computer; wherein services recommended are selected based on a location (e.g., city, state,

Art Unit: 3639

country) [0082]; [0084]; thereby indicating utilizing demographic and /or geographical information;

selecting a type of communication by one of the users [0062]; [0084];

automatically delivering an item by one of said document-related service [0062] – [0069];

generating and transferring user fees, postage costs, and special service mail provider costs [0097].

Furthermore, Greco teaches that said server obtains necessary information from the user via convenient forms provided to the user [0089].

However, Greco does not specifically teach that said forms include *forms, which are used for creation said document* (communication).

Heston teaches a method and system for performing legal services over the Internet, wherein a client is presented with a choice of legal documents to be created. In use, the client selects the legal document that he wants to prepare, and enters into the legal document form necessary information to create the legal document [0105]; [0025]; [0006].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Greco to include that said database, residing in said service provider server remotely from the user computer, includes forms which are used for creation of a document, as disclosed in Heston, because it would advantageously simplify a whole process of creation of a document and delivering it to a recipient. Information as to *special* service is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

Art Unit: 3639

**Claim 2**, Greco teaches means for inputting information (260) by each of the users [0053].

**Claim 3**, Heston teaches a plurality of forms stored in the database, said forms are to be used in creation of a document [0027]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

Information as to *wherein the users may choose any one of the plurality of forms* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 3 are disclosed in Greco in view of Adams as described herein. Also as described the limitations of the claim 3 do not distinguish the claimed apparatus from the prior art.

Furthermore, Greco teaches:

**Claim 4**, a directory of addresses stored in the database [0013]; [0062].

**Claim 5**, means for generating addresses necessary for delivery based on information input by the user [0062]; [0071].

**Claim 6**, means for generating communications based on the information input by the user [0012].

**Claim 7**, means for suggesting mailing requirements based on information input by the user [0012].

**Claim 8**, means for computing postage costs and fees to the user associated with delivery by the special service [0097].

**Claim 9**, means for contacting a supplier necessary to complete delivery of the communication by the special service [0046].

**Claim 10**, means storing information by each of the users [0082]; [0084].

Art Unit: 3639

**Claim 11**, means for generating a report for the user [0097].

**Claim 13**, determining required services for delivery by the special service and costs associated with the delivery [0012]; [0097].

**Claim 14**, providing links to web-sites of said Internet-based document-related service providers [0084] based on information input by the user [0012] and location information (e.g., city, state, country) [0082]; [0084]; thereby indicating utilizing demographic information.

**Claim 15**, Heston teaches: generating the communication based on the information input by the user [0013]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

**Claim 16**, Heston teaches: providing the communication to the user via a display screen [0010]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

**Claim 17**, Greco teaches: itemizing services taken by said Internet-based document-related service providers [0097].

**Claim 18**, Greco teaches: generating a report for the user [0097].

## **(10) Response to Argument**

### **Claim 1.**

Applicant argues that the prior art does not teach or suggest: a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service, as required by Claim 1 (Brief, page 10).

In response to this argument it is noted, that Greco does teach the recited features. Specifically, Greco teaches a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information regarding processing and delivery of a document (communication) (for example legal documents Fig. 5A; and the use of the document preparation software for creating said legal documents [0074]) by appropriate Internet-based document-related services (special services) [0012]-[0014]; [0051]; said appropriate special services are selected based on criteria/factors, said criteria/factors including: information type of service they provide, the user's location, the user's preference, financial or business considerations, etc. [0083]; said database further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084]. More specifically, Greco teaches:

[0014]:

The system includes a **document preparation application** and a graphical user interface. The **document preparation application is configured to create a plurality of documents**. The graphical user interface is integrated within the document preparation application.

[0012]:

The graphical user interface is implemented within a **document preparation application used to create the document**. The graphical user interface includes **instructions for contacting a server to identify available document services; instructions for configuring a plurality of graphical selectable objects based on the available document services, each of the graphical selectable objects corresponding to one of the available document services; instructions for detecting selection of one of the available document services based on selection of one of the graphical selectable objects; and instructions for providing the document from the document preparation application to one or more service providers for performance of the selected document service.**



Art Unit: 3639

[0089]:

The server 120 may then **interact with the user to collect the information necessary to provide the requested document service** [Fig. 8; act 850]. For example, the document the user is currently viewing via the graphical user interface of the document preparation software 320 may be **automatically, securely, and electronically** provided to the server 120.

Further, Greco explicitly teaches providing criteria regarding selection of special service appropriate for the delivery of the communication via a graphical user interface, and storing requirements to effect the delivery of the communication by the special service:

[0062]:

For example, the software buttons may include an **E-Signature Service** button 405, an **Overnight Courier Service** button 410, an **E-Mail Service** button 415, a **Data Storage Service** button 420, a **Traditional Mail Service** button 425, a **Translation Service** button 430, a **Print and Copy Room Service** button 435, a **Government Filing Service** button 440, a **By Hand Delivery Service** button 445, an **Address Book Management Service** button 450, an **E-Collaboration Service** button 455, and various other document services buttons 460.

[0064]:

The Overnight Courier Service button 410 may initiate overnight delivery of the document via a courier service. **This function may provide a price comparison for shipping options, payment via credit or debit card, very late pickup times, and where legally permissible, the assignment of an earlier date to the receipt, transmission, or processing of the document** (e.g., a document received, transmitted, or processed after midnight may be assigned a date of the previous day). **The user may provide the document and delivery instructions** electronically to a secure location of a service provider, which may include a courier service or a service provider operating in partnership with a courier service. When the local service provider (e.g., an east coast service provider) is closed, the document may be automatically delivered to another service provider (e.g., a west coast service provider) that is open. The service provider may print the document, put it in an envelope, and **deliver it according to the user's instructions**.

[0089]:

... The server 120 may also **obtain delivery information and instructions via a convenient form provided to the user**. The form may be provided to the user via a window, such as a browser window or pop-up window. The server 120 may then provide the requested document service for the user [act 860].

While Greco discloses the use of electronic convenient forms to provide the server with necessary information from the user for performing said document-related services [0089], Heston was applied to show the use of said electronic form for creating said communication (for example legal document) in the server environment [0105]; [0025]; [0006].

Applicant argues that the prior art does not teach or suggest that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site.

In response to this argument it is noted that Heston teaches that upon accessing selection by a client a service provider Web site, and selecting a desired document (legal form) to be prepared, the text of the form is presented to the client into which the client enters client-specific information necessary to complete the document [0105]. All steps of preparing the communication are conducted in compliance with requirements/instructions, generated by the system, for guiding the user through necessary steps to successfully achieve the desired by the user document service [0012]. As per the "mailing" step, Greco explicitly teaches said feature. Specifically, Greco teaches:

[0064]:

... The user may provide the document and **delivery instructions electronically to a secure location of a service provider**, which may include a courier service or a service provider operating in partnership with a courier service. When the local service provider (e.g., an east coast service provider) is closed, the document may be automatically

Art Unit: 3639

delivered to another service provider (e.g., a west coast service provider) that is open. **The service provider may print the document, put it in an envelope, and deliver it according to the user's instructions.**

In response to applicant's argument that the prior art does not teach or suggest the step of providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of communication by the special service, stores the communication, it is noted that said arguments are essentially the same as recited above, therefore Examiners response provided above is equally applicable to this arguments. As per the directory of mailing addresses that is accessed to confirm an address of a recipient of the communication, Greco explicitly teaches:

[0071]

The Address Book Management Service button 450 may initiate a function to manage personal and business information of a user. This function may provide a one-click importing of information relating to a recipient of a document. **The function may interact with conventional address/contact book software on one or more devices.**

In response to applicant's argument that the prior art does not teach or suggest a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service, it is noted that said

Art Unit: 3639

arguments are essentially the same as recited above, therefore Examiners response provided above is equally applicable to this arguments.

Claim 12.

Applicant argues that the prior art does not teach or suggest the step of providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication, and automatically mailing the communication by the special service.

In response to this argument it is noted, that Greco does teach the recited features. Specifically, Greco teaches a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information regarding processing and delivery of a document (communication) (for example legal documents Fig. 5A; and the use of the document preparation software for creating said legal documents [0074]) by appropriate Internet-based document-related services (special services) [0012]-[0014]; [0051]; said appropriate special services are selected based on criteria/factors, said criteria/factors including: information type of service they provide, the user's location, the user's preference, financial or business considerations, etc. [0083]; said database further

Art Unit: 3639

includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084]. More

specifically, Greco teaches:

[0014]:

The system includes a **document preparation application** and a graphical user interface. The **document preparation application is configured to create a plurality of documents**. The graphical user interface is integrated within the document preparation application.

[0012]:

The graphical user interface is implemented within a **document preparation application used to create the document**. The graphical user interface includes **instructions for contacting a server to identify available document services; instructions for configuring a plurality of graphical selectable objects based on the available document services, each of the graphical selectable objects corresponding to one of the available document services; instructions for detecting selection of one of the available document services based on selection of one of the graphical selectable objects; and instructions for providing the document from the document preparation application to one or more service providers for performance of the selected document service.**

[0089]:

The server 120 may then **interact with the user to collect the information necessary to provide the requested document service** [Fig. 8; act 850]. For example, the document the user is currently viewing via the graphical user interface of the document preparation software 320 may be **automatically, securely, and electronically** provided to the server 120.

Further, Greco explicitly teaches providing criteria regarding selection of special service appropriate for the delivery of the communication via a graphical user interface, and storing requirements to effect the delivery of the communication by the special service:

[0062]:

For example, the software buttons may include an **E-Signature Service** button 405, an **Overnight Courier Service** button 410, an **E-Mail Service** button 415, a **Data Storage Service** button 420, a **Traditional Mail Service** button 425, a **Translation Service** button

Art Unit: 3639

430, a Print and Copy Room Service button 435, a **Government Filing Service** button 440, a **By Hand Delivery Service** button 445, an Address Book Management Service button 450, an E-Collaboration Service button 455, and various other document services buttons 460.

[0064]:

The Overnight Courier Service button 410 may initiate overnight delivery of the document via a courier service. **This function may provide a price comparison for shipping options, payment via credit or debit card, very late pickup times, and where legally permissible, the assignment of an earlier date to the receipt, transmission, or processing of the document** (e.g., a document received, transmitted, or processed after midnight may be assigned a date of the previous day). **The user may provide the document and delivery instructions** electronically to a secure location of a service provider, which may include a courier service or a service provider operating in partnership with a courier service. When the local service provider (e.g., an east coast service provider) is closed, the document may be automatically delivered to another service provider (e.g., a west coast service provider) that is open. The service provider may print the document, put it in an envelope, and **deliver it according to the user's instructions**.

[0089]:

... The **server 120 may also obtain delivery information and instructions via a convenient form provided to the user**. The form may be provided to the user via a window, such as a browser window or pop-up window. The server 120 may then provide the requested document service for the user [act 860].

While Greco discloses the use of electronic convenient forms to provide the server with necessary information from the user for performing said document-related services [0089], Heston was applied to show the use of said electronic form for creating said communication (for example legal document) in the server environment [0105]; [0025]; [0006].

As per the directory of mailing addresses that is accessed to confirm an address of a recipient of the communication, Greco explicitly teaches:

[0071]

The Address Book Management Service button 450 may initiate a function to manage personal and business information of a user. This function may provide a one-click importing of information relating to a recipient of a

Art Unit: 3639

document. **The function may interact with conventional address/contact book software on one or more devices.**

Furthermore, Greco specifically teaches that in response to information inputted by the user via the graphical user interface, the system (the server 120) generates requirements/instructions for guiding the user through necessary steps for effecting the desired document services, including automatically mailing said communication by the special services [0012]; [0064].

As per the database that stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication, Greco explicitly teaches said feature:

[0071]

The Address Book Management Service button 450 may initiate a function to manage personal and business information of a user. This function may provide a one-click importing of information relating to a recipient of a document. **The function may interact with conventional address/contact book software on one or more devices.**

Applicant argues that the prior art does not teach or suggest the step of automatically mailing the communication by the special service, generating fees and automatically paying the fees.

In response to the this argument it is noted that Greco teaches:

[0064]

When the local service provider (e.g., an east coast service provider) is closed, the **document may be automatically delivered to another service provider (e.g., a west coast service provider) that is open. The service provider may print the document, put it in an envelope, and deliver it according to the user's instructions.**

As per "generating fee" feature, Greco teaches:

Art Unit: 3639

[0097]

The server 120 may also **consolidate the fees incurred for various document-related services** requested by the user and **provide a periodic (e.g., monthly) bill** to the user. **The bill may itemize the various services to aid the user in identifying the costs.**

As per "paying the fees" feature, Greco teaches:

[0064]

The Overnight Courier Service button 410 may initiate overnight delivery of the document via a courier service. This function may provide a price comparison for shipping options, **payment via credit or debit card...**

Applicant argues that the Examiner has merely located components of Appellant's claimed invention, and that a teaching, suggestion, or incentive must exist to make the combination made by Appellant.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, In this case, both references relate to providing document related services over the Internet. The motivation to combine modify Greco to include that said remote database, residing in said service provider server, includes forms which are used for creation of a document,



Art Unit: 3639

as disclosed in Heston, would be to simplify a whole process of creation of a document and delivering it to a recipient.

Claim 5.

Applicant argues that the prior art does not teach or suggest a means for generating addresses necessary for the delivery of information.

In response to this argument it is noted that Greco explicitly teaches said feature:

[0071]

The Address Book Management Service button 450 may initiate a function to manage personal and business information of a user. This function may provide a one-click importing of information relating to a recipient of a document. **The function may interact with conventional address/contact book software on one or more devices.**

Claim 7.

Applicant argues that the prior art does not teach or suggest a means for suggesting mailing requirements based on information input by the user.

In response to this argument it is noted that Greco specifically teaches: that in response to information inputted by the user via the graphical user interface, the system (the server 120) generates requirements/instructions for guiding the user through necessary steps to successfully achieve the desired by the user document service [0012].

Claim 8.

Art Unit: 3639

Applicant argues that the prior art does not teach or suggest a means for computing postage costs and fees to the user associated with the delivery by the special service.

In response to this argument it is noted that Greco teaches:

[0097]:

**The server 120 may also consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g., monthly) bill to the user. The bill may itemize the various services to aid the user in identifying the costs.**

wherein the server 120 is said means for computing postage costs and fees to the user.

Claim 9.

Applicant argues that the prior art does not teach or suggest a means for contacting a supplier necessary to complete the delivery of the communication by the special services.

In response to this argument Examiner stipulates that Greco explicitly teaches this feature:

[0046]

**Any of the functions offered through the toolbar may be offered on a direct basis through the entity providing the system. Conversely, any of the functions offered through the toolbar may be provided in conjunction with established providers of the functions outside the system (e.g., FedEx, Kinko's, UPS, DHL, the U.S. Post Office, etc.).**

Claim 13.

Applicant argues that the prior art does not teach or suggest determining required services for the delivery by the special service and costs associated with the

Art Unit: 3639

delivery.

In response to this argument Examiner stipulates that Greco teaches providing links to web-sites of the Internet-based document-related service providers [0084] based on information input by the user and client location information (e.g., city, state, country) [0082] - [0084]. As per determining costs associated with the delivery, Greco teaches providing monthly bills to the user for special services rendered, said bills including itemization of services rendered to the user [0097].

Claim 14.

Applicant argues that the prior art does not teach or suggest providing suggestions for complying with requests for delivery by the special service based on the demographics input by the user and the communications chosen by the user.

In response to this argument Examiner stipulates that Greco teaches: in response to the client request for a special service, providing links to web-sites of the Internet-based document-related service providers [0084] based on information input by the user and client location information (e.g., city, state, country) [0082] - [0084]; [0012], thereby indicating utilizing demographic information.

Claim 15.

Applicant argues that the prior art does not teach or suggest generating the communication based on information input by the user.

Art Unit: 3639

In response to this argument it is noted that Greco teaches a process of creating a document during which the client is presented (on-line) with a choice of legal documents to be created; then the client selects the desired document to be prepared. In response to the selection step the client is presented with a form (template) for a selected legal document, into which the clients enters necessary information such as name, address, etc [0105].

#### Claim 17.

Applicant argues that the prior art does not teach or suggest providing dates and times of steps taken by a special service mail provider in mailing the communication.

In response to this argument it is noted that Greco teaches:

[0097]

The server 120 may also consolidate the fees incurred for various document-related services requested by the user and **provide a periodic (e.g., monthly) bill** to the user. **The bill may itemize the various services to aid the user in identifying the costs.**

Examiner stipulates that providing/generating monthly bills to the user for special services rendered, said bills including itemization of services rendered to the user suggests providing dates and times of steps taken by a special service mail provider in mailing the communication.

#### Claim 18.

Applicant argues that the prior art does not teach or suggest generating a report of actions taken by a special service mail provider.

Art Unit: 3639

In response to this argument it is noted that Greco teaches:

[0097]

The server 120 may also **consolidate the fees incurred for various document-related services** requested by the user and **provide a periodic (e.g., monthly) bill** to the user. **The bill may itemize the various services to aid the user in identifying the costs.**

Examiner stipulates that providing/generating consolidated statement including itemized services utilized by the user indicates generating a report of actions taken by a special service mail provider.

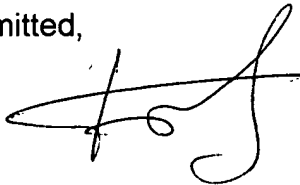
### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor N. Borissov



Conferees:

John Hayes W.

Sam Sough

